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European Patent Office
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PCT CHAPTER II

**Re: Agent's File Reference A3-158 PCT
International Patent Application No. PCT/US03/31881
International Filing Date: 08 October 2003
Priority date: 25 October 2002
MEMORY CARD ADAPTER FOR CONNECTING A MINIATURE
CARD TO A STANDARD CARD CONNECTOR, ALONG WITH A
METHOD OF FABRICATING SAME**

ARTICLE 34 RESPONSE TO THE WRITTEN OPINION ISSUED UNDER RULE 66

Dear Sirs:

This communication is in response to the Written Opinion issued under PCT Rule 66 and mailed on 17 August 2004. This response is being transmitted by facsimile and a confirmation copy of this letter is being sent to the EPO by Express Mail.

In the Written Opinion, the Examiner indicated that "[t]he present application does not meet the requirements of Article 33(3) PCT because the subject matter of the claim 1 is not inventive". The Examiner's reason for his conclusion that claim 1 is not inventive is as follows:

The disclosure of D1 is providing the same advantages as the subject-matter of claim 1, namely connecting a card of one standard to a slot for a card of another standard. The skilled person would therefore regard it as a normal option to adapt the disclosure of D1 in order to facilitate insertion of a miniature memory card in a standard memory card connector. Therefore, the subject-matter of claim 1 does not involve an inventive step [Article 33(3) PCT].

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However, a disclosure that *provides the same advantages of a claim* is not the same as a disclosure that discloses the elements of a claim. Independent claim 1 describes an adapter for a memory card connector to enable a miniature memory card (18) to be inserted into a larger, standard memory card connector (16), characterized by

a two-part housing means (26,28) of a size and shape to simulate a standard memory card and including an inner cavity (20) for receiving a miniature memory card (18), the housing means including a base housing (26) defining a substantial portion of said inner cavity and an inner housing (28) separate from and independent of the base housing; and

a plurality of terminals (48) stamped and formed of conductive sheet metal material, each terminal including a first contact portion (48a) at one end thereof for engaging an appropriate contact (24) on the standard memory card connector (16), a second contact portion (48c) at an opposite end thereof for engaging an appropriate contact (54) of the miniature memory card (18) and a mounting section (48d) between said opposite ends, the mounting sections of the terminals being press-fit into terminal-receiving passages (44) in the inner housing (28).

Applicants claim 1 is directed to an adapter *of a size and shape to simulate a standard memory card* and which includes, *inter alia*, a plurality of terminals wherein each terminal includes *a first contact portion for engaging a contact on the memory card connector and a second portion for engaging a contact on the miniature memory card*. Reference D1 does NOT include these elements, nor does it follow that since D1 provides the same advantages of claim 1, a skilled person would adapt D1 to facilitate insertion of a miniature memory card into a standard memory card connector. The disclosure of D1 is directed to a memory card connector which receives a *card* which is equipped with an I/O type connector which in turn is adapted to receive an *adapter* which receives a miniature memory card. This structure is *very* different from the claimed invention. Applicants' invention is directed to a memory card connector which receives an *adapter* which receives a miniature memory card. The adapter of applicants' invention includes a plurality of terminals each having a first contact portion for engaging a contact on the memory card connector and a second contact portion for engaging a contact on the miniature memory card. The configuration of the connector-card-adapter-smart card arrangement in D1 utilizes at least 5 sets of terminals (two sets in the memory card, and three sets in the adapter) whereas the configuration of the connector-adapter-memory card arrangement of applicants' invention uses only a single set of terminals (as claimed) to electrically and mechanically connect the connector to the memory card. Applicants invite the Examiner to identify or support his conclusion that going from a set of 5 terminals to a set of one terminal is a "normal option for a skilled person in the art".



Figures 1 and 4 of applicants' drawings show the claimed feature(s) clearly, i.e. the adapter which is of a size and shape to simulate a standard memory card and the plurality of terminals wherein each terminal includes a first contact portion for engaging a contact of the card connector and a second contact portion for engaging a contact of the memory card. Applicants invite the examiner to identify where such details are disclosed in the D1 reference.

Accordingly, it is applicants' opinion that the rejection of the claims in view of reference D1 is unfounded. In view of the foregoing, applicants respectfully request that the Examiner reconsider the relevancy of the cited reference D1 and reissue a favorable detailed examination.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Stacey E. Caldwell".

Stacey E. Caldwell
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